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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

NELSON, A

ART UNIT

PAPER NUMBER

1638

DATE MAILED:

07/10/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/235,875

Applicant(s)

Lara Madison, et al.

Examiner

Amy Nelson

Group Art Unit

1638



☒ Responsive to communication(s) filed on Jan 22, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-34 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-34 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8, 11-27, and 31-33, drawn to transformation method with PHB polymerase DNA, classified in class 435, subclass 468, for example.
 - II. Claims 1-8, 11-27, and 31-33, drawn to transformation method with PHA polymerase DNA, classified in class 800, subclass 278, for example.
 - III. Claims 1-8, 11-27, and 31-33, drawn to transformation method with B-ketothiolase DNA, classified in class 435, subclass 69.1, for example.
 - IV. Claims 1-8, 11-27, and 31-33, drawn to transformation method with B-ketoacyl-CoA reductase DNA, classified in class 435, subclass 471, for example.
 - V. Claims 1-8, 11-27, and 31-33, drawn to transformation method with D-specific enoyl-CoA hydratase DNA, classified in class 435, subclass 455, for example.
 - VI. Claims 1-8, 11-27, and 31-33, drawn to transformation method with butyryl-CoA dehydrogenase DNA, classified in class 800, subclass 288, for example.
 - VII. Claims 1-8, 11-27, and 31-33, drawn to transformation method with butyryl-CoA dehydrogenase DNA, classified in class 435, subclass 468, for example.

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- VIII. Claims 1-8, 11-27, and 31-33, drawn to transformation method with 3-hydroxybutyryl-CoA dehydrogenase DNA, classified in class 800, subclass 278, for example.
- IX. Claim 28, drawn to method for producing polyhydroxybutyrate-co-3-hydroxyhexanoate, classified in class 426, subclass 53, for example.
- X. Claim 29, drawn to method for producing 3-hydroxyhexanoate copolymers with butyrate, classified in class 435, subclass 262, for example.
- XI. Claim 30, drawn to method for producing 3-hydroxyhexanoate copolymers with butanol, classified in class 435, subclass 271, for example.
- XII. Claim 34, drawn to polyhydroxybutyrate-co-3-hydroxyhexanoate, classified in class 528, subclass 354, for example.

Claims 1-8, 11-27, and 31-33 are generic, and will be examined to the extent that they read on the elected invention.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III, IV, V, VI, VII, VIII, IX, X, and XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the transformation methods with the different DNAs (*i.e.* Groups I-VIII) have different starting materials, different end products, and different purposes, and therefore are not related. Also, different searches and considerations would be required for examination of the

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different groups. Each of the DNAs from the different groups would need be searched separately, and the effect of modification of the the different DNAs would be expected to differ in view of the large complex pathways involved in PHA biosynthesis, and the highly regulated control of the different biosynthetic steps. Therefore, it is deemed that restriction of the methods with the different genes is proper. Moreover, the methods of Groups IX, X, and XI are unrelated because they have different starting materials, different method steps, and different purposes, and therefore are not related.

3. Inventions I and XII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case polyhydroxybutyrate-co-3-hydroxyhexanoate of Group XII could be made by another method such as any of the methods of Groups II-XI.

4. Inventions II and XII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case polyhydroxybutyrate-co-3-hydroxyhexanoate of Group XII could be made by another method such as any of the methods of Groups I, or III-XI.

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5. Inventions III and XII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case polyhydroxybutyrate-co-3-hydroxyhexanoate of Group XII could be made by another method such as any of the methods of Groups I, II or IV-XI.

6. Inventions IV and XII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case polyhydroxybutyrate-co-3-hydroxyhexanoate of Group XII could be made by another method such as any of the methods of Groups I-III or V-XI.

7. Inventions V and XII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case polyhydroxybutyrate-co-3-hydroxyhexanoate of Group XII could be made by another method such as any of the methods of Groups I-IV or VI-XI.

8. Inventions VI and XII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be

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used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case polyhydroxybutyrate-co-3-hydroxyhexanoate of Group XII could be made by another method such as any of the methods of Groups I-V or VII-XI.

9. Inventions VII and XII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case polyhydroxybutyrate-co-3-hydroxyhexanoate of Group XII could be made by another method such as any of the methods of Groups I-VI or VIII-XI.

10. Inventions VIII and XII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case polyhydroxybutyrate-co-3-hydroxyhexanoate of Group XII could be made by another method such as any of the methods of Groups I-VII or IX-XI.

11. Inventions IX and XII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case

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polyhydroxybutyrate-co-3-hydroxyhexanoate of Group XII could be made by another method such as any of the methods of Groups I-VIII, X or XI.

12. Inventions X and XII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case polyhydroxybutyrate-co-3-hydroxyhexanoate of Group XII could be made by another method such as any of the methods of Groups I-IX or XI.

13. Inventions XI and XII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case polyhydroxybutyrate-co-3-hydroxyhexanoate of Group XII could be made by another method such as any of the methods of Groups I-X.

14. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, recognized divergent subject matter, and because the search required for one of the groups is not required for another, restriction for examination purposes as indicated is proper.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

16. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy J. Nelson whose telephone number is (703) 306-3218. The examiner can normally be reached on Monday-Friday from 8:00 AM - 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Lynette Smith, can be reached at (703) 308-3909. The fax phone number for this Group is (703) 308-4242 or (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application, or if the examiner cannot be reached as indicated above, should be directed to the Group receptionist whose telephone number is (703) 308-1234.



**AMY NELSON
PATENT EXAMINER**

Amy J. Nelson, Ph.D.

July 6, 2000